

20. The fuel of claim 11 wherein step e) further includes depositing the resultant solid char in an inverted cone-shaped bin and injecting steam thereinto.

REMARKS

1. Claims 1-20 were rejected under 35 U.S.C. § 112.

The office action rejected Claims 1-20 on the grounds that the specification “does not reasonably provide enablement for all carbonaceous materials,” or for “all inert organic matter.” Specifically, the office action observes that the claims, which recite “carbonaceous material,” read on “coke, subbituminous coal, and bitumen.” The office action further observes that the claims, which recite “inert organic matter,” read on “sawdust, deashed and desulfurized coal, lignin, etc.”

“Compliance with the enablement requirement of 35 U.S.C. 112, first paragraph does not turn on whether an example is disclosed.” MPEP § 2164.02. “In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. MPEP § 2164.04 (citing *In re Wright*, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. 1993)). “A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. *Id.*

As the examiner observes, the claims read upon the use of coke, subbituminous coal, and bitumen as the “carbonaceous material” recited by the claims, and the use of sawdust, deashed and desulfurized coal, and lignin as the “inert organic material” recited by the claims. Per MPEP § 2164.02, quoted above, there is no requirement that the specification disclose every example that might fall within the scope of the claim language. As stated in the first paragraph of the section of the specification entitled “Description of the Preferred Embodiment,” only certain embodiments of the invention are disclosed by the specification. The scope of the invention includes application of the principles of the invention and modifications to the disclosed embodiments which would occur to a person of ordinary skill in the art, and therefore such modifications and applications are intended to be covered by the claims. Thus, the relevant inquiry is whether the specification is sufficient to enable a person of ordinary skill in the art to make and use the invention with carbonaceous materials other than the specific examples recited.

Per MPEP § 2164.04, quoted above, in order to make a rejection for lack of enablement the examiner must establish a reasonable basis to question then enablement. The Office Action recites no such basis for questioning the specification’s enablement with respect to other carbonaceous materials, or other inert organic materials, or both. Indeed, as a person of ordinary skill in the art, Applicant submits that it would be impossible to recite any such basis, since virtually any carbonaceous materials and inert organic materials can be used in the methods of Claim 1-10, or to produce the fuels of Claims 11-20, with either no modifications whatever to the teachings of the

specification, or with only such modifications as would have been obvious to a person of ordinary skill in the art at the time the application was filed. It is therefore respectfully submitted that the rejection cannot be sustained, and Applicant requests that it be withdrawn.

Claims 5, 6, 15, 16, and 21 were rejected under 35 U.S.C. § 112, second paragraph, on the grounds that they are “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Specifically, Claims 5 and 15 were rejected for including the term “thin,” which is alleged to be indefinite, and to have no “comparative value.” Claims 6 and 16 were rejected for including the term “high,” which is alleged to be indefinite, and to have no “comparative value.” Claim 21 was rejected “because ‘dry trash’ encompasses any of the other listed organic additives. Also, it is questioned how the lignite and peat of (b) differs from those of (a).”

Claims 5 and 15 have been amended to replace “thin” with a specific range corresponding to the definition of “thin” that was provided in the specification (6-12 inches). It is therefore respectfully submitted that the rejection has been obviated with respect to these claims.

Claims 6 and 16 have been amended to eliminate the limitation “high.” It is therefore respectfully submitted that the rejection of these claims has been obviated.

With respect to Claim 21, it is respectfully submitted that the rejection does not identify any basis for indefiniteness. The union of a set of subsets, such as is often used

in Markush groups, is definite, and consists of every element that is a member of at least one of those subsets. “The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not necessarily render the scope of the claim unclear.” MPEP § 2173.05(h). Although Claim 21 is not technically a Markush claim, since it does not use the language “selected from the group consisting of,” it is logically analogous. Just as with a Markush group, the mere fact that an element might belong to more than one subset recited as defining the set does not render that definition indefinite, since it is plain that the element is a member of the set whether it belongs to one of the subsets, several of the subsets, or all of them. Thus, even if it is true that one or more of the other items listed in Claim 21 might also be an example of “dry trash,” the Claim is not indefinite.

Applicant therefore respectfully requests the rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

2. Claims 1, 3, 5, 9, 11, 13, 15, 19, and 21 were rejected under 35 U.S.C. § 102(b), as being anticipated by Bennett (US 4,273,643).

Claims 1, 3, 5, 9, 11, 13, 15, 19, and 21 were rejected as being anticipated by Bennett (US 4,273,643). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (*quoting* Verdegall Bros. v. Unision Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Claims 1 and 11 specifically require “the addition of inert organic matter.”

Claims 3, 5, and 9 depend from Claim 1, and therefore includes each of its limitations,

including the one recited above. Likewise, Claims 13, 15, and 19 depend from Claim 11, and therefore includes each of its limitations, including the one recited above.

Bennett nowhere discloses this limitation. For that matter, no where does Bennett discuss organic matter in any form or for any purpose.

Similarly, Claim 21 specifically requires “adding up to about 20 weight percent of an organic additive to the carbonaceous precursor material.” As mentioned above, Bennett nowhere discusses organic matter, in connection with this limitation, or any other.

It is therefore respectfully submitted that Bennett ‘643 does not anticipate the present invention, and Applicant therefore respectfully requests the rejection be withdrawn.

3. Claims 2, 4, 10, 12, 14, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett.

Claims 2, 4, 10, 12, 14, and 20 were rejected as being obvious over Bennett (US 4,273,643). “To establish a prima facie case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As discussed above in Section 2, Claims 1 and 10 each specifically require “the addition of inert organic matter.” Claims 2, 4, and 10 each depend upon Claim 1, and therefore include each of its limitations, including the one recited above. Likewise, Claims 12, 14, and 20 each depend from Claim 11, and therefore likewise include this limitation.

As discussed above, nowhere does Bennett teach or suggest this limitation, or, for that matter, discuss organic matter in any capacity. It is therefore respectfully submitted that the cited reference is insufficient to sustain prima facie obviousness, and Applicant respectfully requests the rejection be withdrawn.

CONCLUSION

For the foregoing reasons, Applicant submits that all claims are in a condition for allowance, and respectfully requests a Notice of Allowance for all pending claims.

Attached hereto are 3 pages which present a marked up version of the changes made to this application by the current amendment. The first page of the 3 attached pages is captioned “VERSION WITH MARKINGS TO SHOW CHANGES MADE.” The undersigned welcomes a telephonic interview with the Examiner, if the Examiner believes that such an interview would facilitate review of this Amendment Response.

No fees are believe to be necessary. Nevertheless, the Commissioner is hereby authorized to charge any fees due, including statutory fees for extensions

of time, to Deposit Account No. 23-3030, but not to include any payment of issue fees.

Respectfully submitted,

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